

### **REMARKS**

The present amendment is in response to the Office Action dated October 24, 2003, where the Examiner has rejected claims 1-15. By the present amendment, claim 6 has been amended. Accordingly, claims 1-15 are pending in the present application. Reconsideration and allowance of pending claims 1-15 in view of the amendments and the following remarks are respectfully requested.

#### **A. Objection to the Specification.**

The Examiner has objected to the abstract for containing the phrase "F:\PAPS\KYOCERA\NAVIGATION KEY pap.doc." Responsive to the Examiner's request for correction, applicant has deleted the phrase "F:\PAPS\KYOCERA\NAVIGATION KEY pap.doc" from the second paragraph of the abstract. Applicant respectfully submits that the abstract now meets the requirements of MPEP §608.01(b).

#### **B. Objection to Claim 6.**

The Examiner has objected to claim 6 as containing a typographical error. Claim 6 has been amended to replace "microprocesor" with --microprocessor--. Applicant respectfully submits that claim 6 is now in condition for allowance.

#### **C. Rejection of Claims 1-13 and 15 under 35 U.S.C. §102.**

The Examiner has rejected claims 1-13 and 15 under 35 U.S.C. §102(a), as being anticipated by U.S. Patent Application Publication No. 2002/0142738 to Jambie, et al. (hereinafter "Jambie '738"). Initially, applicant notes that Jambie '738 is improperly cited as a

35 U.S.C. §102(a) reference since the October 3, 2002 publication date of Jambie '738 fails to predate the May 9, 2001 effective filing date of the present application. See, e.g., MPEP 706.02(b). Applicant believes that the Examiner intended to cite Jambie '738 under 35 U.S.C. §102(e) for purposes of rejecting claims 1-13 and 15, as addressed in the following remarks.

Applicant respectfully submits that the present invention, as defined by pending claims 1-15, is patentably distinguishable over Jambie '738. In any event, applicant can swear behind, and does hereby swear behind, the March 27, 2001 effective priority date of Jambie '738 under 37 C.F.R. § 1.131.

Under 37 C.F.R. § 1.131, the inventor(s) of the claimed invention may submit an appropriate declaration to overcome a reference. The showing of facts shall be such as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference to a subsequent reduction to practice or to the filing of the application. See 37 C.F.R. § 1.131. For the reasons that follow, applicant respectfully submits that claims 1-15 are allowable over Jambie '738.

Pursuant to 37 C.F.R. § 1.131, attached is a declaration from the sole inventor, Brad Lemley, including a copy the Invention Disclosure entitled "A Method And Apparatus For Combining Multiple User Interface Functions Into A Single Set Of Keys Using A Function Toggle Key In Combination With Prediction Of Intended Function." The Examiner will note that the Invention Disclosure shows and describes a mobile phone including an exemplary "combined navigation/number keypad" capable of functioning as "either a navigation pad or a number/text entry pad" during operation. Moreover, the Invention Disclosure describes a "menu" (or "M") key capable of toggling between a navigation mode and a number/text entry

mode of the combined navigation/number keypad, and further describes that the operating mode of the combined navigation/number keypad may be predictively-controlled and/or user-controlled. Furthermore, the Invention Disclosure describes that the "Enter", "End", "menu", and "clear" (or "C") keys are capable of being assigned to a number of other functions. As such, the Invention Disclosure evidences conception of the invention of the subject matter of the above-referenced application, as specified by pending claims 1-15, in the United States prior to March 27, 2001, the effective priority date of Jambie '738.

Furthermore, as declared by the inventor, Brad Lemley, in the attached declaration, the inventor exercised due diligence from prior to March 27, 2001 in reducing the invention to practice in the United States by, at the latest, May 9, 2001, which is the filing date of the present application.

Accordingly, applicant respectfully requests that the rejection of pending claims 1-13 and 15 under 35 U.S.C. §102(e) be withdrawn.

**D. Rejection of Claim 14 Under under 35 U.S.C. §103.**

The Examiner has further rejected dependent claim 14 under 35 U.S.C. §103(a) as being unpatentable over Jambie '738 (or FR 2823045) in view of U.S. Patent No. 6,125,287 to Cushman, et al. (hereinafter "Cushman '287"). As discussed above, the rejection of independent claim 6 under 35 U.S.C. §102(e) as to Jambie '738 (and equally as related to priority foreign application FR 2823045) should be withdrawn. Since the present rejection of claim 14 under 35 U.S.C. §103(a) is based on the same primary reference relied upon in rejecting independent claim 6 under 35 U.S.C. §102(e), namely, Jambie '738, the rejection of claim 14 depending from independent claim 6 under 35 U.S.C. §103(a) should, *a fortiori*, be withdrawn. Furthermore, the

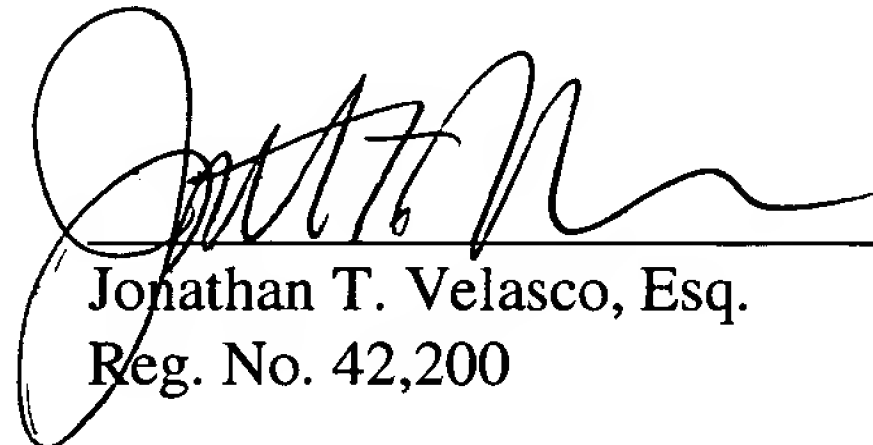
disclosure of Cushman '287 fails to teach, disclose or suggest the invention as specified by claim 14. For example, the Examiner has cited Cushman '287 as only disclosing "pressing a SEND key for calling a name stored in a directory." Accordingly, claim 14 should now be allowed.

**E. Conclusion.**

For all the foregoing reasons, an early allowance of claims 1-15 pending in the present application is respectfully requested.

Respectfully Submitted;

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